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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/525,690 | 10/24/2006 | Raed Al-Qawasmeh | 16526US01 | 7654 |

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| EXAMINER | |
|---|---|
| POWERS, FIONA | |
| ART UNIT | PAPER NUMBER |
| 1626 | |

| MAIL DATE | DELIVERY MODE |
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| 07/20/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/525,690 | AL-QAWASMEH ET AL. | |
| | Examiner | Art Unit | |
| | Fiona T. Powers | 1626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *16,18-21,23-26 and 28-79* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *16,18-21,23-26 and 28-79* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

**DETAILED ACTION**

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 62, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and R3 are unsubstituted or substituted phenyl or unsubstituted or substituted naphthyl; and R1 is unsubstituted or substituted phenyl.

Group II, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 62, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and/or R3 are pyridyl; and R1 is unsubstituted or substituted phenyl.

Group III, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 62 and 67 (all in part), drawn to methods using compounds wherein R2 and/or R3 are thienyl; and R1 is unsubstituted or substituted phenyl.

Group IV, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 62, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and R3 together form a phenanthrene ring system; and R1 is unsubstituted or substituted phenyl.

Group V, claim(s) 16, 18-20, 28-32, 35-38, 47, 48 and 52-57 (all in part) drawn to methods using compounds wherein R2 and R3 together form a phenanthroline ring system; and R1 is unsubstituted or substituted phenyl.

Group VI, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-59, 62-64, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and R3 are unsubstituted or substituted phenyl or unsubstituted or substituted naphthyl; and R1 is unsubstituted or substituted indolyl

Group VII, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-58, 62, 63, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and/or R3 are pyridyl; and R1 is unsubstituted or substituted indolyl.

Group VIII, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-58, 62, 63, 67, 75 and 76 (all in part), drawn to methods using compounds wherein R2 and/or R3 are thienyl; and R1 is unsubstituted or substituted indolyl.

Group IX, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 60-62 and 65-67, drawn to methods using compounds wherein R2 and R3 together form a phenanthrene ring system; and R1 is unsubstituted or substituted indolyl.

Group X, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-57, 60, 62, 65 and 67 (all in part), drawn to methods using compounds wherein R2 and R3 together form a phenanthroline ring system; and R1 is unsubstituted or substituted indolyl.

Group XI, claim(s) 16, 18-20, 28-32, 35-38, 47, 48, 52-67, 75 and 76 (all in part), drawn to methods using compounds not embraced by Groups I to X.

Group XII, claim(s) 21, 33, 34, 39, 46, 49-51 and 72 (all in part), drawn to compounds and compositions wherein R2 and R3 are unsubstituted or substituted phenyl or unsubstituted or substituted naphthyl; and R1 is unsubstituted or substituted phenyl.

Group XIII, claim(s) 21, 33, 34, 39, 46, 49-51 and 72 (all in part), drawn to compounds and compositions wherein R2 and/or R3 are pyridyl; and R1 is unsubstituted or substituted phenyl.

Group XIV, claim(s) 21, 33, 34, 39, 39, 46, 49-51 and 72 (all in part), drawn to compounds and compositions wherein R2 and/or R3 are thienyl; and R1 is unsubstituted or substituted phenyl.

Group XV, claim(s) 21, 33, 34, 39, 46, 49-51 and 72 (all in part), drawn to compounds and compositions wherein R2 and R3 together form a phenanthrene ring system; and R1 is unsubstituted or substituted phenyl.

Group XVI, claim(s) 21, 33, 34, 39, 46, 49-51 an d72 (all in part), drawn to compounds and compositions wherein R2 and R3 together form a phenanthroline ring system; and R1 is unsubstituted or substituted phenyl.

Group XVII, claim(s) 21, 23, 24, 33, 34, 39-41, 44, 46, 49-51, 68, 69, 72, 73, 77 and 78 (all in part), drawn to compounds and compositions wherein R2 and R3 are unsubstituted or substituted phenyl or unsubstituted or substituted naphthyl; and R1 is unsubstituted or substituted indolyl.

Group XVIII, claim(s) 21, 23, 33, 34, 39, 40, 44, 46, 49-51, 68, 72, 73 and 77 (all in part) drawn to compounds and compositions wherein R2 and/or R3 are pyridyl; and R1 is unsubstituted or substituted indolyl.

Group XIX, claim(s) 21, 23, 33, 34, 39, 40, 44, 46, 49-51, 68, 72, 73 and 77 (all in part), drawn to compounds and compositions wherein R2 and/or R3 are thienyl; and R1 is unsubstituted or substituted indolyl.

Group XX, claim(s) 21, 25, 26, 39, 42, 43, 45, 46, 49-51, 70-72, 74 and 79 (all in part), drawn to compounds and compositions wherein R2 and R3 together form a phenanthrene ring system; and R1 is unsubstituted or substituted indolyl.

Group XXI, claim(s) 21, 25, 39, 42, 45, 46, 49-51, 70, 72, 74 and 77 (all in part), drawn to compounds and compositions wherein R2 and R3 together form a phenanthroline ring system; and R1 is unsubstituted or substituted indolyl.

Group XXII, claim(s) 21-26, 33, 34, 39-46, 49-51, 68-74 and 77-79 (all in part), drawn to compounds and compositions not embraced by Groups XII to XXI.

The inventions listed as Groups I to XXII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature common to Groups I to XXII is 2,4,5-

trisubstituted imidazole compounds. This is not a special technical feature because the compounds are anticipated or rendered obvious by the prior art. See the compounds disclosed in Mjalli et al. (US 5700826); the compounds of Table I of Bhaduri et al., cited by applicants in the IDS filed 5/29/2007; and Registry Numbers 309285-51-6, 330449-52-0, 332148-67-1 and 404904-57-0, for example.

In addition, it would be an undue burden on the examiner and the patent office resources if all of the claims were examined in a single application as separate patent, literature and computer searches would need to be done.

***Election of Species***

Claims 16, 18-21, 23-26 and 28-79 are generic to the following disclosed patentably distinct species: Compound Numbers 1-84 shown on pages 25 to 32 of the specification. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Additionally, if one of Groups I to XI is elected, applicants are further required to elect a single disease or condition and specific microbial cell that is disclosed in the specification as originally filed, for example, fungal infection and *Candida albicans*; bacterial infection and *Chlamydia*

*pneumoniae;* bacterial infection and *Salmonella typhimurium;* bacterial infection and *Staphylococcus aureus;* etc.

Applicant is required under 35 U.S.C. 121 to elect a **single** disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species,** including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product

claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction

requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art Unit 1626

ftp
July 16, 2009